



Express Mail Label No.: EV 524874466 US
Date of Deposit: November 30, 2004

PATENT
Docket No. 2003P19072US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Inventors: Park, et al.

Filed: March 15, 2004 Examiner: Unassigned

Serial No.: 10/800,950 Group Art Unit: Unassigned

For: System and Method for Actively Cooling Transducer Assembly
Electronics

The specification of which:

(a) ☒ was filed on March 15, 2004, as Application Serial No. 10/800,950

**STATEMENT OF FACTS SUPPORT OF FILING ON BEHALF OF
NONSIGNING INVENTORS (37 C.F.R. § 1.47(a))**

This statement is made as the exact facts that are relied upon to establish the diligent effort made to secure the execution of the declaration by the nonsigning inventor for the above-identified patent application before deposit thereof in the Patent and Trademark Office.

- ☒ Because signing on behalf of the nonsigning inventor is by a person or entity showing a sufficient proprietary interest, this statement also recites facts as to why this action was necessary to preserve the rights of the parties or to prevent irreparable damages.

This statement is being made by the available person having first-hand knowledge of the facts recited therein.



IDENTIFICATION OF PERSON MAKING THIS STATEMENT OF FACTS

Name: Jenny G. Ko
Registration No.: 44,190
Business Address: Siemens Corporation
1230 Shorebird Way, Building 4
Mountain View, CA 94043

LAST KNOWN ADDRESS OF THE NONSIGNING INVENTOR

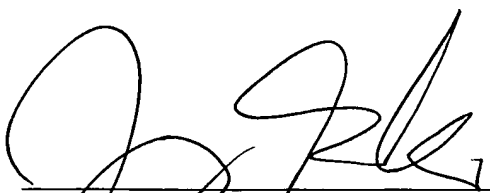
Full name of
nonsigning inventor: Mirsaid Bolorforosh
Last known address
Of nonsigning inventor: 3250 South Castanya Way, Portola Valley, CA 94028

STATEMENT OF FACTS IN SUPPORT OF PETITION TO PERMIT FILING A PATENT APPLICATION WHEN AN INVENTOR REFUSES OR CANNOT BE REACHED TO SIGN THE OATH OR DECLARATION (37 C.F.R. § 1.47)

1. I, Jenny G. Ko, registration number 44, 190, am the prosecuting attorney for United States Patent Application No. 10/800,950, filed March 15, 2004 entitled, "System and Method for Actively Cooling Transducer Assembly Electronics", invented by William J. Park, Vaughn Marian, David Petersen, Todor Sheljaskow, Mirsaid S. Bolorforosh, Worth B. Walters and Sevig Ayter (hereinafter "the '950 application").
2. Mr. Bolorforosh was previously an employee of Siemens Medical Solutions, USA, Inc. (hereinafter "SMS"). His last day of employment was July 16, 2004. (Exh. A, October 2004, 4:05 pm e-mail from Elie Barbarito to Jenny G. Ko)
3. A copy of Mr. Bolorforosh's Proprietary Information and Inventions Agreement (hereinafter "the Inventions Agreement"), dated April 20, 1998 is attached as Exhibit B.
4. Siemens Medical Solutions USA, Inc. (hereinafter "SMS") acquired all the assets and liabilities of Acuson Corporation effective January 1, 2003. (Exh. C.)
5. The Inventions Agreement states that "all inventions which I develop (in whole or part, either alone or jointly with others) during the period of my employment . . . shall be the sole property of the Company. . . . I hereby assign to the Company

any rights I may have or acquire in such inventions. I further agree as to all such inventions to assist the Company in every proper way In the event that the company is unable for any reason whatsoever to secure my signature to any lawful and necessary document require to apply for or execute any patent applications with respect to such an Invention . . . I hereby irrevocably designate and appoint the Company and its duly authorized officers and agents as my agents and attorney-in-fact to act for and in my behalf and instead of me, to execute and file any such application" (Exh. B, ¶ d.)

6. Elie Barbarito of the Human Resources Department for the Ultrasound Division of SMS provided an address where I could send the papers for execution of the '950 application to Mr. Bolorforosh. (Exh. D, July 28, 2004, 4:08 PM e-mail from Elie Barbarito to Jenny Ko.)
7. On August 13, 2004, I sent a letter to Mr. Bolorforosh's last known address requesting him to sign the assignment, power of attorney, and declaration papers for the '950 application to SMS. (Exh E.)
8. On October 22, 2004, I sent a letter to Mr. Bolorforosh's last known address requesting him once again to sign the assignment, power of attorney, and declaration papers for the '950 application to SMS. (Exh. F).
9. To date, I have received no response from Mr. Bolorforosh, and have not received the returned letter.
10. Based on the foregoing facts, I respectfully petition to permit filing of the '950 application when an inventor refuses to sign the Oath or Declaration, as described in 37 C.F.R. § 1.47(a).



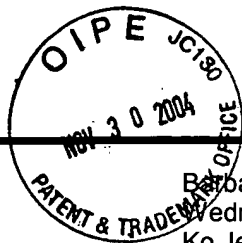
JENNY G. KO

Reg. No. 44,190

Telephone: 650-694-5810

Date: 11-16-04

Attachments: Exhibits A, B, C, D, E, and F



Ko Jenny

From: Barbarito Elie
Sent: Wednesday, October 20, 2004 4:05 PM
To: Ko Jenny
Subject: RE: Said Bolorforosh

Jenny,

Said's last day of employment was 7/16/04.

Said voluntarily resigned to go work for a competitor. He gave 2 weeks notice on 7/6, last day worked was 7/7 and exit interview was conducted on 7/9. His official last day was 7/16/04.

Thanks,
Elie

-----Original Message-----

From: Ko Jenny
Sent: Wednesday, October 20, 2004 3:57 PM
To: Barbarito Elie
Subject: RE: Said Bolorforosh

Elie - thank you for your quick response. Please also let me know his last day of employment.

-Jenny

-----Original Message-----

From: Barbarito Elie
Sent: Wednesday, October 20, 2004 3:55 PM
To: Ko Jenny
Subject: Said Bolorforosh

Hi Jenny,

Per your vm, attached is a PDF of the Acuson Corporation Proprietary Information and Inventions Agreement signed by Said when he joined the company.

Thanks,
Elie

-----Original Message-----

From: mvp351d@siemens.com [mailto:mvp351d@siemens.com]
Sent: Wednesday, October 20, 2004 7:58 AM
To: Barbarito Elie
Subject: Scan from a Xerox Document Centre

Please open the attached document. It was scanned and sent to you using a Xerox Document Centre.

Sent by: Guest [mvp351d@siemens.com]
Number of Images: 2
Attachment File Type: PDF



ACUSON CORPORATION
PROPRIETARY INFORMATION
AND INVENTIONS AGREEMENT

4/20, 1998

ACUSON CORPORATION
1220 Charleston Road
Mountain View, CA 94039

Gentlemen:

In consideration of my employment by ACUSON CORPORATION or any of its subsidiaries (the "Company"), I hereby agree as follows:

1. I recognize that the Company is engaged in a continuous program of research, development and production respecting its business, present and future, including fields generally related to its business.
2. I understand and agree that my employment creates a relationship of confidence and trust between me and the Company with respect to any information:
 - a. applicable to the business of the Company; or
 - b. applicable to the business of any client or customer of the Company.
3. I understand and agree that the Company possesses "Proprietary Information" which includes, but is not limited to, trade secrets, ideas, processes, formulas, data and know-how, computer programs, files or printouts, improvements, inventions, techniques, marketing plans, strategies, forecasts and customer lists. (Without limiting the foregoing, data transferred electronically to me, i.e. by modem, e-mail or physical transfer of computer-readable files, shall be deemed "Proprietary Information.") Some of this Proprietary Information will have been developed by me in the course of my employment with Acuson.
 - a. I understand and agree that all Proprietary Information, and any related patents, copyrights, trademarks or rights associated therewith are the sole property of the Company and its assigns. As an employee of the Company, I assign to the Company any rights I may have or acquire in such Proprietary Information. At all times, both during my employment by the Company and after its termination, I will keep in confidence and trust all Proprietary Information, and I will not use or disclose any Proprietary Information or anything relating to it without the written consent of the Company, except as may be necessary in the ordinary course of performing my duties to the Company. I will at all times fully and accurately document, in writing, any Proprietary Information or Inventions (as hereinafter defined) developed by me so that the Company will properly own and utilize such Proprietary Information and Inventions to its full benefit.
 - b. All documents and records (including any copies stored in any computer memory or other storage medium), and apparatus, equipment and other physical property, whether or not pertaining to Proprietary Information, furnished to me by the Company or produced by myself or others in connection with my employment shall be and remain the sole property of the Company and shall be returned, or destroyed, immediately, whenever requested by the Company. Even if the Company does not so request, I shall return and deliver all such property or any reproduction of such property upon my termination.
 - c. I will promptly disclose to the Company or any persons designated by it, all inventions, improvements, ideas, formulas, processes, techniques, know-how and data, whether or not patentable, made or conceived or reduced to practice or learned by me, either alone or jointly with others, during the term of my employment ("Inventions").
 - d. I agree that all Inventions which I develop (in whole or part, either alone or jointly with others) during the period of my employment and which (i) are developed with the use of equipment, supplies, facilities or Proprietary Information of the Company, or (ii) are developed during the hours for which I am compensated by the Company, or (iii) relate to the business of the Company or its actual or demonstrably anticipated research and development or (iv) result, in whole or in part, from work performed by me for the Company, shall be the sole property of the Company and its copyrights, trademarks and other rights in connection therewith. I hereby assign to the Company any rights I may have or acquire in such Inventions. I further agree as to all such Inventions to assist the Company in every proper way (but at the Company's expense) to obtain, and from time to time enforce, patents, copyrights, trademarks and other rights and protections relating to said Inventions in any and all countries, and to that end I will execute all documents for use in applying for obtaining, sustaining and enforcing such patents, copyrights, trademarks and other rights and protections, both during and after my employment with the Company. In addition, I will execute, verify and deliver assignments of such patents, copyrights, trademarks and other rights and protection to the Company or its designee. In the event that the Company is unable for any reason whatsoever to secure my signature to any lawful and necessary document required to apply for or execute any patent applications with respect to such an Invention (including renewals, extensions, continuations, divisions or continuations in part thereof), I hereby irrevocably designate and appoint the Company and its duly authorized officers and agents as my agents and attorneys-in-fact to act for and in my behalf and instead of me, to execute and file any such application and to do all other lawfully permitted acts to further the prosecution and issuance of patents thereon with the same legal force and effect as if executed by me. I agree that my obligations to assist the Company in obtaining, enforcing and assigning patent, copyright, trademark, and other rights and protections respecting Inventions shall, subject to the Company providing me with reasonable compensation for these efforts, survive the termination of my employment with the Company.
 - e. I have attached to this statement a complete and accurate list of all inventions, improvements, ideas, formulas, processes, techniques, know-how and data, whether or not patentable, made or conceived or reduced to practice or learned by me, either alone or jointly with others not then in the employ of the Company ("Personal Inventions") that I consider to be my property and that I exclude from the scope of this letter. I agree that such list is accurate and complete. I agree that I will not use any Personal Inventions in the course of my employment with the Company without the prior written consent of the Company.

EXHIBIT B

- f. I represent that the performance by me of this agreement is not in conflict with any other agreement or obligation I have, including without limitation any agreements written or oral with a previous employer or client. I also certify that I will not enter into any agreement, either written or oral, in conflict with obligations described in this document.
- g. I acknowledge that I have previously had access to the proprietary information of other businesses and, in some cases, individuals. I will not disclose this information to the Company or use such proprietary information in the course of my employment with the Company, unless and until this information has become public knowledge or is independently developed at the Company.
- h. This agreement does not require assignment of an invention which I can prove fully qualifies under the provisions of Section 2870 of the California Labor Code. However, I will disclose any inventions regardless of whether I believe the invention is protected by Section 2870, in order to permit the Company to engage in a review process to determine whether a particular invention falls under the code. Such disclosure shall be received in confidence by the Company.

Section 2870 of the California Labor Code reads as follows:

- 1.) Any provisions in an employment agreement which provide that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:
 - a.) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer.
 - b.) Result from any work performed by the employee for the employer.
- 2.) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a.), the provision is against the public policy of this state and is unenforceable.
- I. I understand, in addition, that the Company has received and in the future will receive from third parties confidential or proprietary information ("Third Party Information") subject to a duty on the Company's part to maintain the confidentiality of such information and to use it only for certain limited purposes. During the term of my employment and thereafter, I will hold Third Party Information in the strictest confidence and will not disclose or use Third Party Information except as permitted by the agreement between the Company and the third party, unless expressly authorized to act otherwise by an officer of the Company.
4. This agreement shall be effective as of the first day of my employment by the Company.
5. This agreement shall be binding upon me, my heirs, executors, assigns and administrators and shall inure to the benefit of the Company, its successors and assigns.
6. I understand that employment at Acuson is "at will" and may be terminated by either party with or without notice for any reason or for no reason.

Dated: 4-20-, 1998

M. S. B. LA

Employee Signature

MIR SAID SEYED-BOLORFOROSH

Employee Name (Type or Print)

602-410-6472

Social Security Number

Accepted and Agreed to:

ACUSON CORPORATION

By [Signature]

Authorized Representative

HR Specialist

Title

(1/1/96)

SIEMENS



**Certificate
of
Assistant Secretary
of
Siemens Medical Solutions USA, Inc.**

The undersigned DOES HEREBY CERTIFY that he is the duly elected and qualified Assistant Secretary of Siemens Medical Solutions USA, Inc., a corporation organized under the laws of the State of Delaware (the "Corporation"), and a wholly-owned subsidiary of Siemens Corporation, and was the former Secretary of Acuson Corporation, a corporation organized under the laws of the State of Delaware and also a wholly-owned subsidiary of Siemens Corporation.

The undersigned DOES HEREBY FURTHER CERTIFY that effective 1 January 2003, the Corporation acquired substantially all of the assets and liabilities of its affiliate, Acuson Corporation, and, accordingly, the Corporation is the successor-in-interest to Acuson Corporation.

IN WITNESS WHEREOF, the undersigned has affixed his signature as Assistant Secretary.

Date: October 20, 2004

A handwritten signature in black ink, appearing to read "Charles H. Dearborn", written over a horizontal line.

Charles H. Dearborn
Assistant Secretary, Siemens Medical
Solutions USA, Inc. and former
Secretary, Acuson Corporation

Siemens Medical Solutions USA, Inc.

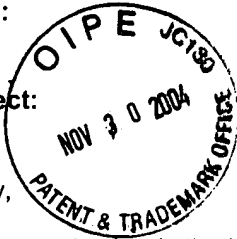
Ultrasound Division

1230 Shorebird Way
P.O. Box 7393
Mountain View, CA 94039-7393

EXHIBIT C

Ko Jenny

From: Barbarito Elie
Sent: Thursday, August 19, 2004 10:17 AM
To: Ko Jenny
Subject: RE: Said Bolorforosh



Jenny,

Unfortunately, that is the last update we have in our files/database.

Elie

-----Original Message-----

From: Ko Jenny
Sent: Wednesday, August 18, 2004 3:13 PM
To: Barbarito Elie
Subject: RE: Said Bolorforosh

Hi - I've heard that this address is no longer applicable, as he may have moved to Schenectady, NY. Do you have any further contact info for him?

thanks,
Jenny

-----Original Message-----

From: Barbarito Elie
Sent: Wednesday, July 28, 2004 4:08 PM
To: Ko Jenny
Subject: Said Bolorforosh

Hi Jenny,

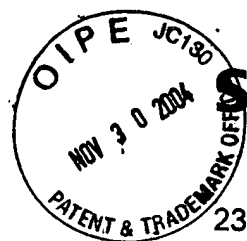
Per your request from Christy Pawlovich, here's Said's last contact info we add on file:

250 South Castanya Way
Portola Valley, CA 94028
650-233-8834

Regards,

SIEMENS Medical Solutions
Ultrasound Division

Elie Barbarito
Human Resources
E-Mail: elie.barbarito@siemens.com



SIEMENS

23 August 2004

Mirsaid Bolorforosh
250 South Castanya Way
Portola Valley, CA 94028

Re: U.S. Patent Application Serial No. 10/800,950 filed March 15, 2004 for
SYSTEM AND METHOD FOR ACTIVELY COOLING TRANSDUCER
ASSEMBLY ELECTRONICS
Our File: 2003P19702US

Dear Mirsaid:

We are now in receipt of the Notice to File Missing Parts for the above-identified patent application. A response is due in the Patent Office by September 1, 2004. A copy of the application was sent to you in April 2004, along with your copy of the Award Letter.

Enclosed are the documents to be signed by you. If there are any changes that need to be made to the document(s), please make them in blue pen, then initial and date each change. Once they meet with your approval, please sign the assignment in the presence of two witnesses, who will also need to sign the assignment.

If you have any questions, please feel free to contact my assistant, Raquel at raquel.west@siemens.com or (650) 694-5333. We look forward to receiving the executed application at your earliest convenience. A return self-addressed envelope is enclosed for your convenience. Thank you.

Best regards,

Jenny G. Ko
Intellectual Property Counsel
West Coast Office
Direct Dial: (650) 694-5810
Fax: 650-968-4517
E-Mail: jenny.ko@siemens.com
JGK/jlt
Enclosures

Siemens Corporation

Intellectual Property Department
West Coast Office

1230 Shorebird Way, Bldg. 4
P.O. Box 7393
Mountain View, CA 94039-7393

IP Hotline: (650) 943-7066
General: (650) 969-9112
Fax: (650) 968-4517

EXHIBIT E



SIEMENS

October 2004

Mirsaid Bolorforosh
250 South Castanya Way
Portola Valley, CA 94028

Re: U.S. Patent Application Serial No. 10/800,950 filed March 15, 2004 for
SYSTEM AND METHOD FOR ACTIVELY COOLING TRANSDUCER
ASSEMBLY ELECTRONICS
Our File: 2003P19702US

Dear Mirsaid:

We are now in receipt of the Notice to File Missing Parts for the above-identified patent application.

Enclosed are the documents to be signed by you and a copy of the filed patent application. If there are any changes that need to be made to the document(s), please make them in blue pen, then initial and date each change. Once they meet with your approval, please sign the assignment in the presence of two witnesses, who will also need to sign the assignment. We previously sent you a letter, dated August 23, 2004, requesting that you execute these documents.

A copy of the Acuson Corporation Proprietary Information and Inventions Agreement that you executed on April 20, 1998 is also enclosed. Please note that paragraph 2.d of this Agreement states that you will "execute, verify and deliver assignment of such patents."

If you have any questions, please feel free to contact my assistant, Raquel at raquel.west@siemens.com or (650) 694-5333. We look forward to receiving the executed application at your earliest convenience. A return self-addressed envelope is enclosed for your convenience. Thank you.

Best regards,

Jenny G. Ko
Intellectual Property Counsel
West Coast Office
Direct Dial: (650) 694-5810
Fax: 650-968-4517
E-Mail: jenny.ko@siemens.com
JGK/rcw
Enclosures

Siemens Corporation

Intellectual Property Department
West Coast Office

1230 Shorebird Way, Bldg. 4
P.O. Box 7393
Mountain View, CA 94039-7393

IP Hotline: (650) 943-7066
General: (650) 969-9112
Fax: (650) 968-4517

EXHIBIT F